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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,410

06/21/2002

Peter Eriksson

59760 (47137)

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EDWARDS ANGELL PALMER & DODGE LLP  
P.O. BOX 55874  
BOSTON, MA 02205

EXAMINER

KETTER, JAMES S

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

08/31/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,410	<b>Applicant(s)</b> ERIKSSON ET AL.	
	<b>Examiner</b> James S. Ketter	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-15,17-22,31-33 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-15,17-22,31-33 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-15, 17-22, 31-33 and 36-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 38, and claims 2-6, 8-15, 17-22, 31-33, 36, 37, 39 and 40 that depend therefrom, the recitation of “kV/cm” is confusing as the claimed invention may have only a single electrode. In this instance, where presumably the other “electrode” would be ground, the electrical field would not have a single, uniform field strength, and thus it is not clear if the limitation of the claim would be met. As such, the metes and bounds of the claims are unclear.

With further respect to claims 1, 9 and 38, and claims 2-6, 8, 10-15, 17-22, 31-33, 36, 37, 39 and 40 that depend therefrom, the recitation that a microelectrode is “sufficiently small to permit the selective fusion” of the cell and the fusion partner is indefinite. The maximum size that the microelectrode might have is situation-dependent, and open-ended. For example, were there a target cell and its fusion partner in a very large vessel, e.g., an industrial fermentor or bioreactor, the electrode could be many centimeters, or even meters in width, if the cell and partner were the only such particles present. While this is an extreme example, it serves to demonstrate that the limitation in question in the instant claims does not appear to have an actual upper boundary, leaving the metes and bounds of the instant claims unclear.

With respect to claims 2-5, 8, 31 and 32, and claims 6, 9-15 and 33 which depend therefrom, the instant claims recite “the electrical field in step B”; however, the electrical field is

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recited in step C. As such the claim lacks proper antecedent basis and is rendered confusing as well.

With respect to claims 6 and 33, the phrase “a microchip of a suitable design for combinatorial synthesis of fusion products” is unclear. The term “suitable design” is purely functional, and conveys no structural information, but is used to define a structure. This is problematic particularly because it is not clear what “suitable” means, i.e., what degree of function is required to meet this limitation? If the device could be caused to have barely minimal function with the assistance of other unspecified devices or unusual operating conditions, would that be “suitable”? As such, the claims are unclear for this reason.

Regarding claims 9 and 10, the phrase “such as” (recited in claim 9) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 6 recites “one electrode(s) is (are)...” However, one alternative of this language would read “one electrodes are”, which is grammatically unclear.

Claim 32 recites “several electrodes”, but claim 3, from which it depends, only recites two. Thus, its is not clear what “several” means as it normally would include numbers greater than two.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK  
30 August 2010

/James S. Ketter/  
Primary Examiner, Art Unit 1636